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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/685,736      | 10/16/2003  | Hiroataka Fukushima  | ED-US020432         | 6123             |

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/685,736

**Applicant(s)**

FUKUSHIMA ET AL.

**Examiner**

Greg Binda

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-20 and 30-49 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15, 16, 18, 19 and 30-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 17, 20 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The claim listing in the amendment filed May 17, 2005 fails to include claim numbers 21-29. Applicant is reminded that all claims, even the canceled claims, must appear in the claim listing.

*Election/Restrictions*

3. Claims 13, 15, 16, 18, 19 & 30-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 9, 2004.

*Claim Objections*

4. Claim 14 is objected to because in line 7 the word "a" should be inserted prior to "second".

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 14, 17, 20 & 47-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claim 14, lines 12+ recites the limitation "said first torsion angle range [where the first frictional resistance generating portion is inoperable] being located in any range of the two relative rotatable members". Claim 17, lines 11 & 12 and claim 20, lines 10 & 11 recite the same limitation with slightly different wording. However, there does not appear to be a written description of the this limitation in the description of the elected species in the application as originally filed. To the contrary, in the description of the elected species at paragraph 0054, the first torsion angle range A where the first frictional resistance generating portion 61d is inoperable is expressly disclosed as occurring between 8 and 10 degrees (NOT "any angle") of relative rotation between the two relative rotatable members 2 & 21.

b. Claims 47 & 48 recite that the first and second frictional resistance generating portions are arranged at a common radial position. Claim 49 recites the same limitation with slightly different wording. Applicant has not pointed out where this limitation is supported, nor does there appear to be a written description of the limitation in the application as originally filed.

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7. Claims 14, 17, 20 & 47-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a. Claim 14, lines 12+ recites the limitation “said first torsion angle range [where the first frictional resistance generating portion is inoperable] being located in any range of the two relative rotatable members”. Claim 17, lines 11 & 12 and claim 20, lines 10 & 11 recite the same limitation with slightly different wording. However, the description of the elected species fails to teach such a capability. To the contrary, in the description of the elected species at paragraph 0054, the first torsion angle range A where the first frictional resistance generating portion 61d is inoperable is expressly disclosed as occurring between 8 and 10 degrees (NOT “any angle”) of relative rotation between the two relative rotatable members 2 & 21.

b. Claims 47 & 48 recite that the first and second frictional resistance generating portions are arranged at a common radial position. Claim 49 recites the same limitation with slightly different wording. However, the specification and drawings fail to teach such structure, where instead, the first (intermediate) frictional resistance generating portion 28, 61d is shown as occurring at radial position inside of the (i.e. less than) the radial position of the second (large) friction generating portion 21a, 44, 61a, 61b.

*Response to Arguments*

8. Applicant's arguments filed May 17, 2005 have been fully considered but they are not persuasive.

a. Applicant argues that claims 13, 15, 16, 18, 19 & 30-46 should be examined because each of these claims recites at least two frictional resistance generating portions.

However, the claims remain withdrawn because: (1) applicant failed to identify them as reading on the elected species at the time of the election; (2) applicant has failed to show how each claim reads on the elected species (i.e. applicant has not shown (by specific reference to the drawings and description) how every limitation in each combination of limitations in the withdrawn claims reads on the elected species); and (3) each of the withdrawn claims includes limitations which do not read on the elected species and thus each claim is directed to a combination that does not read on the elected species.

b. Applicant argues that a limitation identified as new matter (see item 6a above) is supported at page 7, lines 17-20. Although it is not particularly clear what that portion of the specification is summarizing, it is clear that it fails to support the offending limitation. The summary there discusses a "frictional suppressing mechanism". No such mechanism is recited in the claims. Further, as noted in item 6a above, the offending limitation is *expressly* contradicted in the original description of the elected species.

c. At page 20 of the arguments, applicant states that the elected species has "only one frictional resistance portion 61". That argument does not appear to square with the description where the friction washer 61 is described as having two distinct portions

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61a,b and 61d that operate separately to generate friction. The portion 61d operates in regions B & C and the other portion 61a,b operates only in region C.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

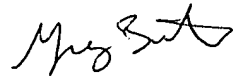
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda  
Primary Examiner  
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